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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,009	08/25/2003	Amlan Datta	129843.1104	3329

60148 7590 10/12/2007
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EXAMINER

MARCANTONI, PAUL D

ART UNIT	PAPER NUMBER
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1793

MAIL DATE	DELIVERY MODE
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10/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Art Unit: 1793

The applicants' 9/18/07 RCE and response has been considered but is unpersuasive.

New Matter:

Claims 1,5, 6, and 12-15 are rejected under 35 USC 112 first paragraph and 35 USC 132 as the specification as originally filed does not provide support for the invention as is now claimed.

The numeral "59" with reference to amount of silicon oxide (should be correctly amended to silicon dioxide or silica) is new matter because there is only support for 58.9 wt% silicon dioxide from page 33 (synthetic microsphere A) of applicants' specification.

Provisional ODP

Claims 1,5, 6, and 12-15 remain provisionally rejected on the grounds of non-statutory obviousness type double patenting as being unpatentable over claims 1-27 and 1-15 of copending application nos. 2004/0081827 A1 (Datta et al.) and 2004/0079260 A1 (Datta et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach a composition comprising microspheres that overlap the composition of one another. Overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art. Further, the applicants' new intended use of a known composition in their claims 12-15 is not a patentable distinction. The new use of a composition that is already known is not patentable.

Art Unit: 1793

35 USC 102/103:

Claims 1,5,6, and 12-15 are rejected under 35 USC 102(b) as anticipated by, or, in the alternative, under 35 USC 103(a) as obvious over Beck et al. (3M Patent-US Patent Number 3,365,315-also listed on page 11 paragraph [0038] of applicants' specification) or Goetz et al. (US Patent Number 4,983,550).

Response:

Should applicants amend their claim to 58.9 wt% silicon dioxide which is supported by applicants disclosure, the examiner will withdraw the new matter rejection.

Beck:

It is noted that Beck still meets applicants' claims because applicants' claim about 30 to 59 (wt)% silicon dioxide. The minimum silicon dioxide is 60 wt% silicon dioxide in Beck meets "about 59 wt% silicon dioxide" or even "about 58.9 wt% silicon dioxide". "About" permits some tolerance. At least about 10% was held to be anticipated by a teaching of a content not to exceed about 8%. In re Ayers, 154 F 2d 182, 69 USPQ 109 (CCPA 1946). A pressure limitation of 2-15 PSI was held to be readable on a reference which taught a pressure "of the order of about 15 PSI." In re Erickson, 343 F 2d 778, 145 USPQ 207 (CCPA 1965). The examiner disagrees with applicants that Beck does not teach the final composition of his final microspheres. The examiner refers applicants to table I in column 4 (lines 25-40). That is represents what would be the final composition of the glass microspheres.

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Goetz:

Applicants argue that Goetz does not teach less than 2 wt% potassium oxide.

The examiner disagrees. A look at the chart in claim 1 indicates that R_2O can be 2 to 15 weight percent of the hollow glass spheres. R_2O can be Na_2O alone in amounts meeting applicants claims of "about 4 to 10 wt%" in Goetz thus still meeting applicants' claims.

The examiner disagrees that Goetz does not teach less than 2 wt% potassium oxide.

Claim 2 of Goetz shows that R_2O can be Na_2O alone and thus not require the presence of any potassium oxide. Note that claim 2 has no requirement that there be a mixture or combination of sodium oxide and potassium oxide.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni
Primary Examiner
Art Unit 1755